

REMARKS

The Office Action dated August 9, 2005, has been received and carefully noted. The amendments made herein and the following remarks are submitted as a full and complete response thereto.

By this Amendment, claim 1 is amended. Claims 1-3 are pending in the present application, and are respectfully submitted for reconsideration.

Entry of this Amendment is proper under 37 C.F.R. § 1.116 since this Amendment: (a) places the application in condition for allowance for reasons discussed herein; (b) does not raise any new issue regarding further search and/or consideration since the Amendment amplifies issues previously discussed throughout prosecution; (c) does not present any additional claims without canceling a corresponding number of finally-rejected claims and (d) places the application in better form for appeal, should an appeal be necessary. The Amendment is necessary because it is made in reply to arguments raised in the rejection. Entry of the Amendment is thus respectfully requested.

Claims 1-3 Rejected under 35 U.S.C. § 103(a)

Claims 1-3 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hakkinen et al. (U.S. Patent Publication No. 2001/0023185, hereinafter "Hakkinen") in view of Nakano (U.S. Patent No. 5,933,782). Applicant respectfully traverses the rejection.

Claim 1 recites a radio base station for performing a radio communication comprising, among other features, wherein the mobile station stops the diversity reception and performs a reception using one antenna.

It is respectfully submitted that the prior art fails to disclose or suggest at least the above-mentioned features of the Applicant's invention.

In making the rejection, the Office Action admits that, "Hakkinen does not teach transmitting, when the radio base station starts a communication with a mobile station by the space division multiplex method, and instruction to stop performing a diversity reception to the mobile station." Furthermore, the Office Action notes in the "Response to Arguments" portion that,

[C]ommunication in the space division multiplex method can simply mean communicating with a plurality of different mobile stations or base stations or both at the same time until the best connection is made. The mobile station in Nakano reference communicates with two base stations and the base station control station, at the same time until the best connection is made in which the base station then only communicates with one base station. See page 4 of Office Action.

The Office Action cites Nakano for allegedly curing this deficiency. In particular, the Office Action cites row label 4 in Fig. 16, together with column 9, lines 32-38 of Nakano for support. Applicant submits that the referenced portion of Nakano fails to show such features. For instance, column 9, lines 32-38 merely provides,

In a process (4) of FIG. 16, the base station control station 11 decides an end of the site diversity, and notifies this decision to the mobile station 5 and the base stations 1 and 2. Each of the mobile station 5 and the base stations 1 and 2 which received this notice then switches the transmission power control using the layer-3 control signal to the

transmission power control using the layer-1 control signal.
(Emphasis added).

In contrast, it is respectfully submitted that the present application discloses on page 4, lines 11-18 that,

the radio base station transmits the diversity reception stop instruction to each mobile station which the radio base station is to communicate with by the space division multiplex method. Upon receipt of the diversity reception stop instruction, each mobile station stops the diversity reception and performs a reception using one antenna. This prohibits deterioration of communication quality due to the diversity reception at the mobile station. (Emphasis added).

It is respectfully submitted that the claimed invention, in one example, receives a diversity stop instruction transmitted by the radio base station, and the mobile station stops diversity reception and begins to receive signals using only one antenna. It is further submitted that this is distinguishable from Nakano since Nakano switches the transmission power control when notified about an end of the site diversity.

Hence, Applicant submits that Hakkinen in view of Nakano fails to disclose or suggest each and every element recited in claim 1 of the present application. In particular, it is submitted that the cited art fails to disclose or suggest at least the feature of "wherein the mobile station stops the diversity reception and performs a reception using one antenna."

In order to establish a *prima facie* case of obviousness, each feature of a rejected claim must be taught or suggested by the applied art of record. See M.P.E.P. §2143.03 and In re Royka, 490 F.2d 981 (CCPA 1974). As explained above, Hakkinen in view of Nakano, taken alone or in combination, do not teach or suggest each feature

recited in claim 1. Accordingly, for the above provided reasons, Applicant respectfully submits that claim 1 is not rendered obvious under 35 U.S.C. § 103 by the teachings of Hakkinen in view of Nakano, and therefore is allowable.

As claims 2-3 depend from claim 1, Applicant submits that each of these claims incorporates the patentable aspects therein, and are therefore allowable for at least the reasons set forth above with respect to the independent claim, as well as for the additional subject matter recited therein.

Under U.S. patent practice, the PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002). The Office Action restates the advantages of the present invention to justify the combination of references. There is, however, nothing in

the applied references to evidence the desirability of these advantages in the disclosed structure.

Applicant respectfully requests withdrawal of the rejection.

Conclusion

In view of the above, Applicant respectfully submits that each of claims 1-3 recites subject matter that is neither disclosed nor suggested in the cited prior art. Applicant also submits that the subject matter is more than sufficient to render the claims non-obvious to a person of ordinary skill in the art, and therefore respectfully request that claims 1-3 be found allowable and that this application be passed to issue.

If for any reason, the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact the Applicant's undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper has not been timely filed, the Applicant respectfully petitions for an appropriate extension of time.

Any fees for such an extension, together with any additional fees that may be

due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, referring to client-matter number 101201-00013.

Respectfully submitted,



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